

REMARKS

In the Final Office Action dated June 16, 2005, the Examiner rejected claims 201-204, 206, 207, 210-212, 217, and 218 under 35 U.S.C. §102(b) for the second time as unpatentable over U.S. Patent No. 5,174,374 to Hailey. In response to the Examiner's final rejection, Applicant respectfully traverses on the grounds that the Hailey '374 patent fails to suggest or disclose each and every claim limitation of independent claim 201 as required by law. *See Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). Because remaining claims 202-218 all depend from claim 201, applicant asserts they are patentable for at least the same reason.

Referring now to Claim 201, an expandable reaming tool is claimed. As required in claim 201, the expandable reaming tool includes at least two reamer pads operatively coupled to a tool body and configured to be displaced between a retracted position and an expanded position. Furthermore, the expandable reaming tool includes at least one blade formed on at least one of the at least two reamer pads. Additionally, the expandable reaming tool includes a plurality of cutting elements disposed on the at least one blade, wherein the plurality of cutting elements is arranged so as to substantially balance at least one parameter between the two reamer pads, wherein the at least one parameter can include axial force, lateral force, work, or mass. Furthermore, the expandable reaming tool is configured to ream while drilling.

Applicant respectfully asserts the following elements are missing from the Hailey '374 patent cited by the Examiner in support of the 35 U.S.C. §102(b) rejection.

Configured to ream while drilling

As stated in Applicant's argument filed on March 15, 2005 at page 5, line 18 through page 6, line 8, the device of Hailey '374 is incapable of operating as a *reamer*.

Particularly, Applicant asserts that as the disclosure of Hailey '374 is merely that of an expandable tubing cutting tool to be repeatedly raised and lowered to perform a desired cutting task. Next, the disclosure of Hailey '374 fails to disclose or suggest using the apparatuses disclosed therein as fit for increasing the diameter of a drilled pilot bore. As such, the disclosure of Hailey '374 does not disclose or suggest a reamer as required by rejected claim 201. Furthermore, the cutting blades for Hailey '374 are configured so as to only allow cutting in an upward direction. There are no cutting surfaces on the lower extremities of cutter blades 24a, 24b, so cutting in a downward direction would not be possible. Therefore, even if determined to be a reamer, the device disclosed in Hailey '374 would be incapable of cutting in a downward direction, as would be necessary to perform a reaming while drilling operation.

In response to Applicant's argument, the Examiner identified a second patent, U.S. Patent No. 4,809,793 to Hailey (hereinafter "Hailey '793"), to support his contention that Hailey '374 discloses a reamer capable of reaming while drilling. Applicant respectfully objects to the Examiner's inclusion of a *second* reference in a rejection under 35 U.S.C. §102(b) when the statute and judicial precedent clearly require that each and every element as claimed be within a *single* reference. As there is no statement within Hailey '374 incorporating Hailey '793 by reference therein, the disclosure of Hailey '793 should not be considered part of Hailey '374. Therefore, if the Examiner seeks to use Hailey '793 in combination with Hailey '374 to reject Applicant's claims, that rejection would only be proper under 35 U.S.C. §103. As a result, the Examiner's rejection with regard to claim 1 is improper. Nevertheless, Applicant maintains that even if such a combination were proposed, the result would not be sufficient to maintain a rejection under 35 U.S.C. §103 as the combination would not include each and every element as claimed.

At least one blade formed on at least one of the at least two reamer pads

As stated in Applicant's argument filed on March 15, 2005, at page 6, lines 10-21, the Hailey '374 patent neither discloses nor suggests at least one blade formed on at least one of two reamer pads as required by claim 201. Instead, the Hailey '374 patent merely discloses a pair of cutter blades having hardfaced inserts with an overlay of thermally stable polycrystalline diamond. Nowhere in the Hailey '374 patent are reamer pads disclosed. Therefore, nowhere in the Hailey '374 patent is at least one blade formed on at least one of the reamer pads disclosed. Furthermore, nowhere in the Hailey '374 patent are a plurality of cutter elements disposed on at least one blade disclosed. As such, the reference cited by the Examiner does not disclose or suggest *every* element as claimed in independent claim 201. Therefore, the Examiner's rejection under 35 U.S.C. §102(b) is improper.

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (05516.089003).

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Respectfully submitted,

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